

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
Osamu NAKAMURA	)	
	)	
Serial No.: 10/809,118	)	
(Now Patent No. 7,554,117)	)	Confirmation No.: 7733
	)	
Filed: March 25, 2004	)	
	)	
For: Semiconductor Device And	)	
Manufacturing Method Thereof	)	
	)	
Examiner: Hoai V. Pham	)	
	)	
Art Unit: 2814	)	

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION OF THE  
PATENT TERM ADJUSTMENT DETERMINATION**

Sir:

This is a request for a reconsideration of the patent term adjustment determination in the above application.

The patent term adjustment in the Issue Notification of June 10, 2009 stated that the patent term will be extended by 841 days. However, Applicants respectfully submit that under 35 U.S.C. § 154(b)(2)(A) and 37 C.F.R. § 1.705(d) the patent term should be extended by an additional 487 days, for a total of 1328 days.

### **Statement of the Facts**

In the Issue Notification mailed June 10, 2009, the Office indicated that Applicants are entitled to a 841 day extension of the patent term. The application was filed on March 25, 2004. The Office mailed an Election/ Restriction Requirement on September 17, 2007. Applicants responded to the Election/Restriction Requirement on October 17, 2007. The Office mailed a second Election/Restriction Requirement on December 26, 2007. Applicants responded to the second Election/Restriction Requirement on February 20, 2008. The Office mailed a non-final Rejection on April 30, 2008 to which Applicants filed a response on July 24, 2008. The Office mailed a final Office Action on October 21, 2008 to which Applicants filed a response and a Request for Continued Examination January 16, 2009. The Office mailed a Notice of Allowance on February 23, 2009. The Applicants paid the issue fee on May 22, 2009, and the patent issued on June 30, 2009, as U.S. Patent No. 7,554,117.

### **Patent Term Adjustment Calculations**

Under 37 C.F.R. § 1.702, the patent term adjustment for this application is the sum of the delays listed under § 1.702(a) ("Type A Delays") and § 1.702(b) ("Type B Delays"). Under 37 C.F.R. § 1.704, the patent term adjustment is then reduced by the number of days which are attributed to the Applicants' delay.

### **Type A Delays**

Under § 1.702(a)(1), the patent term is extended by 845 days because the Office issued the Election/Restriction Requirement 845 days (same as above) after the 14 month time period from the day the application was filed. Thus, the total amount of Type A Delays is 845 days.

### **Type B Delays**

Under § 1.702(b), the patent term is extended by 663 days. The Office issued the patent on June 30, 2009, which is 828 days after the 3 year time period from the day the application was filed. The Applicants filed a Request for Continued Examination on January 16, 2009. Under § 1.702(b)(1), Type B Delays do not include any time consumed by continued examination of the applicant under 35 U.S.C. 132(b). The number of days between the date Applicants filed the RCE and the issuance date of the patent is 165 days. Thus, the total amount of Type B Delays is 663.

### **Type 1.704 Reduction**

Under § 1.704, the patent term is reduced by 4 days.

### **Overlap Determination**

Under 35 U.S.C. § 154(b)(2)(A) and 37 C.F.R. § 1.703(f), the period of patent term adjustment, to the extent that the periods of delay “overlap,” should not exceed the actual number of days the issuance of the patent was delayed. Applicants submit that

the Patent Office has misconstrued the meaning of “overlap” by calculating the patent term adjustment according to Type A Delays or Type B Delays, whichever is larger, but not for both Type A Delays and Type B Delays. Accordingly, the Office has calculated the patent term adjustment by using only the Type A Delays (845 days) minus the Type 1.704 Reduction (4 days) for a total of 841 days.

However, the term “overlap,” as recognized in *Wyeth v. Dudas*, 580 F. Supp. 2d 138; 88 U.S.P.Q.2d 1538 (D.D.C. 2008), occurs when the periods of delay actually occur on the same calendar day. As stated by the District Court in *Wyeth*, if Congress had intended the statute to merely guarantee a 17 year patent term, measured from the issue date under prior law, it could have easily drafted the statute accordingly.

Applicants thus submit that under 35 U.S.C. § 154(b)(2)(A) and § 1.703(f), Applicants are entitled to the sum of both Type A Delays and Type B Delays (1508 days), minus the *actual* overlap of any delays that occur on the same calendar day (176 days), and then further subtracting the Type 1.704 Reduction (4 days) for a total patent term extension of 1328 days.

Applicants could not have raised this issue in an application for patent term adjustment because the Type B Delays cannot be calculated until the patent issues.

### **Conclusion**

Therefore, it is respectfully submitted that under the correct interpretation of 35 U.S.C. § 154(b)(2)(A) and § 1.703(f), Applicants are entitled to a patent term adjustment

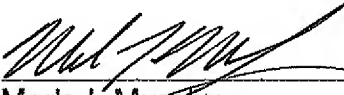
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of 1328 days, and correction of the USPTO's patent term adjustment determination is requested. The fee for this request is paid herewith.

If any additional fee is required, authorization is hereby given to charge Deposit Account 50-1039.

Respectfully submitted,

Dated: August 14, 2009

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